

REMARKS

The present application includes pending claims 1-38, all of which have been rejected. Claims 1 and 29 have been amended to clarify aspects of the invention.

Claims 1-4, 7, 8, 10-12, 14-27, 29-32, 35, 36 and 38 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2004/0261096 ("Matz"). Claims 5, 6, 13, 33 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matz in view of U.S. 2002/0166127 ("Hamano"). Claims 9 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matz in view of U.S. 6,308,329 ("Takahashi"). Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Matz in view of U.S. 6,145,083 ("Shaffer"). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following:

I. Matz Does Not Anticipate Claims 1-4, 7, 8, 10-12, 14-27, 29-32, 35, 36 And 38

The Applicants first turn to the rejection of claims 1-4, 7, 8, 10-12, 14-27, 29-32, 35, 36 and 38 as being anticipated by Matz. Claim 1 recites, in part, "the **set top box circuitry at the first location** causing the displaying, from the storage **at the first location**, of idle state media when no scheduled media is available."

A previous Office Action acknowledged that "Matz does not explicitly teach the set top box circuitry causing the displaying from the storage, of idle state media when no scheduled media is available." *See* August 3, 2007 Office Action at page 3. The current Office Action cites, however, Matz at paragraph [0139] as disclosing this limitation. *See* March 5, 2008 Office Action at page 3.

The Applicants now address this cited portion of Matz. Paragraph [0139] of Matz discloses the following:

In an embodiment, the client device substitutes blocked content with other content that is substantially equal in duration. Thus, for example, if a 30-second advertisement is blocked, the client device identifies and presents substitute content that is also approximately 30 seconds in duration. Similarly if, for example, a 30 minute program is blocked, substitute content is selected that has approximately a 30-minute duration.

Matz at [0139]. Matz also discloses screensavers. *See id.* at, *e.g.*, [0130] and [0138].

Matz discloses, however, a set top box 105 and a server 102 that **are at different locations**. In particular, Matz discloses the following:

In another embodiment, **the client device 105 is a set-top-box (STB)**. In this embodiment, the communication network 106 may be a satellite television broadcast network and **the server 102 may be a head-end of a cable service provider**. The cable server provider generally broadcasts programming, advertising, “walled garden” merchandising offers, and other media content. As mentioned above, the media content is broadcasted in the form of data streams 110, 134, and 136 and associated tags 112, 130, and 132, respectively to the STB 105.

Matz at [0049] (emphasis added). Thus, the server 102 (the cable service provider head-end) is at one location, while the client device 105, such as a set top box, is at another location. This arrangement of the server 102 and client device 105 being at separate and distinct locations is clearly shown in Figure 1 of Matz.

Moreover, Matz discloses that the **server 102**, which is at a different location than the set top box 105, stores media.

FIG. 1 illustrates an exemplary operating environment 100 employing an embodiment of the present invention. A server device 102 communicates with one or more client devices, such as client device 104 and/or client device 105 [set top box], via a

communication network 106. Server device 102 transmits media content, such as, but not limited to, video, audio, text, or executable programs, over the communication network 106 to be used by the client devices 104 and/or 105. Each of the client devices 104 and/or 105 has an output device, such as a computer monitor 114, or a television screen 116, for presenting media content to the user.

The server device 102 has memory 108 that stores media content in the form of data streams 110, 134, and 136.

Matz at Paragraphs [0045]-[0046] (emphasis added). As noted above, the media streams are broadcasted from the server 102 to the set top box 105.

As demonstrated above, media is stored at the server 102, such as a cable head-end, and broadcast to the set top box 105, which is at a different location than the server 102.

Nevertheless, the Office Action also cites Figure 3 of Matz as support for the claim rejections. *See* March 5, 2008 Office Action at page 3. However, a review of Figure 3 shows a “server” and a separate and distinct “client” having a “user input/output module.” Figure 3 does not show that the client is part of the server or vice versa. Indeed, as clearly shown in Figure 1, and as described in Matz, the client 105 is located at a different location than the server 102.

While Matz does disclose “screensavers” (*see* Matz at [0130]) the Office Action has not cited anything that describes, teaches or suggests “the **set top box circuitry at the first location** causing **the displaying**, from **the storage at the first location**, of idle state media when no scheduled media is available.” Thus, for at least this reason, the Applicants respectfully request reconsideration of the rejection of claims 1-4, 7 and 8 as being anticipated by Matz.

Despite the express teaching of Matz as explained above, the Office Action states the following:

In response to applicant's argument ... that Matz ... fails to teach the idle state media being stored at the same location as the set top box circuitry, the examiner respectfully disagrees. Referring to **Fig. 12** Matz clearly teaches selecting a screen saver from a local storage device; in this case field 1210 shows the screen saver is stored on the local hard drive, **[0130]**.

See March 5, 2008 Office Action at page 2 (emphasis added). As shown above, the Office Action relies on Matz at [0130] and Figure 12.

The Applicants respectfully submit, however, that the Office Action does not accurately summarize the Applicants' argument. As detailed above, the Applicants respectfully submit that the Office Action has not cited anything that describes, teaches or suggests "the **set top box circuitry at the first location** causing the displaying, from the storage **at the first location**, of idle state media when no scheduled media is available."

Further, Matz at [0130], which the Office Action relies on (as shown above) states the following:

A screensaver may be selected for substitution via the screensaver selector 1207. A screensaver source typically includes a file having screensaver data, such as one or more displayable images, or displayable image patterns. A file selector, such as the "from file" button 1208 facilitates selection of a screensaver file. The user may select the from file button 1208 using a selection device such as a mouse or remote control. Upon selection from the file button 1208, the user is prompted to enter a file location and name, identifying the screen saver file. The file location and name is displayed in a screensaver file name field 1210.

Matz at [0130]. As the Applicants acknowledge above, this paragraph of Matz merely discloses screensavers, in general. Particularly, this paragraph states that a screensaver may be selected. Further, Figure 12, which paragraph [0130] describes, "illustrates a user interface that may be used to select substitute content for blocked content in one embodiment of the present

invention.” *See id.* at [0033]. The Office Action has not shown or explained how Matz describes, teaches or suggest **set top box circuitry at a first location** that displays idle state media from **a storage also at the first location**. That is, while the Office Action has demonstrates that Matz discloses selectable screensavers, the portions of Matz relied on by the Office Action do not describe, teach or suggest “**set top box circuitry at the first location** causing **the displaying**, from **the storage at the first location**, of idle state media when no scheduled media is available.” Indeed, Matz does not describe, teach or suggest these limitations. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Independent claim 10 recites, in part, “storing the idle state media **at the first location**; causing the displaying of the idle state media **through set top box circuitry at the first location** according to a user defined sequence, if no scheduled media is available.” Similarly, independent claim 15 recites, in part, “storing the media at **the first location**; . . . causing the displaying of the idle state media **through set top box circuitry at the first location** according to a user defined sequence, when no scheduled media is available.” Also, claim 29 recites, in part, “the **set top box circuitry at the first location** causing the displaying, from a storage **at the first location**, of idle state media when no scheduled media is available.” The Applicants respectfully request reconsideration of the rejection of independent claims 10, 15, 29 and the claims that depend therefrom for at least the reasons discussed above with respect to claim 1.

II. The Applicants Request Reconsideration Of The Remaining Rejections

As noted above, claims 5, 6, 13, 33 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matz in view of Hamano. Claims 9 and 37 stand rejected as being

unpatentable over Matz in view Takahashi, while claim 28 stands rejected as being unpatentable over Matz in view of Shaffer. The Applicants respectfully request reconsideration of these rejections for at least the reasons set forth above.

III. Conclusion

In general, the Office Action makes various statements regarding claims 1-38 and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: March 25, 2008

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants